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January 3, 2004

Mail Stop AF - APPEAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

VIA EXPRESS MAIL (EV 130292265 US)
Re: U.S. Patent Application for Child-Resistant Utility Lighter
Inventor: Sung, K.
Examiner: Cocks, J. (Unit 3743)
Serial No.: 09/716,573
Attorney Docket No. 00-11-1450

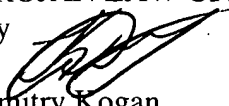
Dear Sir/Madam:

Please find enclosed the following documents:

1. Reply Brief in triplicate (33 pages);
2. Cover Letter (1 page);
3. Return Receipt Postcard (1 page); and
4. Certificate of Mailing by Express Mail (1 page).

This Reply is made to Examiner's Answer, dated November 1, 2004. Because January 1, 2005 was a Saturday, this reply is filed on the following business day, which is today, January 3, 2005. Thus, this reply is made within two months of the Examiner's Answer to Appellant's Brief, and no extension of time under 37 C.F.R. 1.136 is required.

However, If any additional fees are required, please deduct the appropriate fee amount from Deposit Account No. 500703. Our customer number is 23388.

Very truly yours,
TROJAN LAW OFFICES
By 
Dmitry Kogan
Reg. No. 50,868

Enclosures
Cc: Mr. Hon



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: **Kil Yong Sung**

Application No. 09/716,573

Filed: November 17, 2000

For: **Child-Resistant Utility Lighter**

Art Unit 3743

Examiner Josiah C. Cocks

APPELLANT'S REPLY BRIEF

ARGUMENT

Claims 16 and 17, if Properly Construed, are Allowable Over Tasi

Examiner first states that appellant does not point to any structure in appellant's claims that is not present in the Tasi reference. Appellant does not agree with that statement. In fact, if the meaning of the appellant's claims were properly construed, it would be clear that appellant claims are patently distinct from the teachings of the Tasi reference.

It is well known that to ascertain the true meaning of the claims, it is appropriate to consider the claim language, the patent specification, and the prosecution history. *Markman v.*

Westview Instruments, Inc., 52 F.3d 967, 979-980, 34 U.S.P.Q.2d 1321, 1329-1330 (Fed. Cir. 1995). In construing the meaning of appellant's claims in view of the specification, one has no choice but to read claim 16 as requiring that the fuel release valve closes when the safety button is released.

Claims 16 and 17 each recite: "[a] safety button [moves] the spring mechanism from the nonoperational to operational position, ... the spring mechanism being urged into the nonoperational position, ... the second portion [of the spring mechanism] opens the fuel release valve when the spring mechanism is in the operational position, ... [the] fuel release valve being spring loaded so as to be urged in the closed position..." (See Claims 16 and 17.)

In interpreting the meaning of this language, i.e., in determining the scope of the claim, intrinsic evidence such as the specification has to always be considered. In this case, the claimed operation of the spring mechanism is clearly defined in the specification, requiring that once the safety button is no longer pressed, the fuel release valve closes due to the force of the spring mechanism.

For example, the specification states:

"Once a flame has been generated, it can be sustained only if fuel continues to be supplied. As explained above, this will only occur if the safety button (120) is held in position and not released after a flame has been generated. Simply holding the trigger (100) in the activated state will not sustain the flame."

(Specification, page 18.)

The specification also states: "Once the flame is no longer needed, the safety button (120) is released. This allows both the cam lever (80) and the fuel release lever (70) to return to their stationary positions under the urging influence of the return spring (90)." (Specification, pages 18-19.) There is absolutely no language in appellant's specification that leaves open a possibility that the fuel valve can remain open once the safety button is released, and no longer pressed by a finger.

In fact, the specification discloses that the fuel valve can only remain open as long as there is continuous pressure on the safety button. The Examiner's statement that "there is nothing in appellant's claims that requires that the fuel-release valve remain open only as long as the safety button is depressed by a finger" is misguided for the simple reason that the Appellant does not have to include a finger as an element of the claims. The safety button structure present in claims 16 and 17

requires a finger to push it in view of the specification and common sense.

Thus, the meaning of the appellant's claims is clear – the structure of the spring mechanism is such that the fuel-release valve can only remain open as long as the safety button is depressed by a finger. Such a disclosure is not present in Tasi, and the 35 U.S.C. 102(b) rejection of this application over Tasi is not proper.

Tasi Does Not Disclose Safety Button Claimed by the
Appellant

Examiner's own description of the Tasi safety button in the Answer shows that Appellant's safety, as claimed, is distinct from the safety button described in Tasi. In describing the device in Tasi, the Examiner states, "[i]f safety button (36) is released by the finger, the safety button is still depressed by the bottom flange (221) of the firing button (22). Release of the firing button (22) then releases safety button (36), which is biased by spring mechanism (34 and 45) to a non-operational position that functions to prevent movement of the firing button (22). The described safety button and its function is totally different from that of Appellant.

Tasi teaches a slide switch 36, i.e., a safety button, which can be moved down to the operative position and up into the nonoperative position. Tasi further teaches a retainer spring 37 having two projections 371 for holding the slide switch 36 between the operative position (ON) and the non-operative (OFF) position. Col. 2, lines 25-29. Thus, the slide switch can move from the OFF position to the ON position and remain there, since it is held in place by the projections 371. Consequently, the safety button can be moved by a user into the operative position and released, allowing the user to produce a flame by depressing the trigger while no longer physically pressing on the safety button.

In other words, Applicant's invention is a further step in safety as compared to the *Tasi* disclosure. The *Tasi* safety button only helps prevent ignition. Applicant's invention, on the other hand, not only helps prevent accidental ignition, but also, prolonged accidental burning of the flame, should ignition occur. This is because Applicant discloses a fuel release valve that only remains open when the safety button is depressed.

In Applicant's invention, even if accidental ignition were to occur, once the child releases the safety button, the flame

would extinguish, even if the child continued to depress the firing button. This is a claimed safety improvement not taught in the Tasi disclosure. Accordingly, the 102(b) rejection in view of Tasi of claims 16 and 17 is not proper.

Tasi Does Not Disclose that the Fuel Valve is Urged Into a Closed Position by a Spring

In all of the office actions, the examiner has stated that Tasi discloses a fuel-release valve urged into a closed position. In response to Appellant's argument that Tasi does not disclose that the fuel release valve is spring-loaded so as to be urged into a closed position, the Examiner replies, "[h]owever, Tasi discloses that his torch is used with a conventional commercially available disposable cigarette lighter. Examiner's argument sheds light on the Applicant's contention all along, i.e., that Appellant's invention is a novel lighter, and that the Tasi invention is a novel adapter for placing over a conventional lighter in order to create a torch.

As far as the appellant can see, from the Tasi drawings, the Tasi does not disclose a "fuel-release valve being spring loaded so as to be urged into the closed position," as the appellant claims not only in claims 16 and 17, but also in claims 18 and 19 as well. Tasi simply does not disclose this

element of the appellant's invention. Tasi's fuel gas nozzle is not described to be spring loaded so as to be urged into the closed position.

The Tasi Device Does Not Inherently Include Rotational Motion of the Spring Mechanism

Additionally, Appellant would like to respectfully disagree with the examiner's conclusion that a characterization of "rotationally moving" is accurately applied to the movement of the spring mechanism (34 and 35) of Tasi. As can be seen from the Tasi disclosure, the pressure rod (34) goes through a hole in the slide switch (36) and is retained in place by a clamp. Since the pressure rod is attached to the slide switch with the clamp, when the slide switch is moved down, the pressure rod moves downward not because of the movement of the spring (35), but due to the external force applied to the slide switch in moving it down.

Further, while the spring does compress vertically (not rotationally) when the slide switch is moved down, the spring does not apply any force to the pressure rod, but instead simply biases the slide switch in the upward direction. The Appellant's does not believe the website example used by the Examiner to be accurately representative of the actual movement

of the spring in question (35) described in Tasi. Thus, the appellant believes that the examiner's analysis that "portions of the spring engage in rotational movement to translate the force applied to the spring by the safety button (36) to the lower head portion of rod (34)" is incorrect.

Discussion of Material Distinction between Appellant's claims 17 and 19

The Examiner correctly notes that the only difference between claims 17 and claims 19 is with respect to the limitation, "a safety button rotationally moving said spring mechanism." Claim 19 includes the word "rotationally" and claim 17 does not. Even if Tasi's spring inherently included rotational motion, Tasi would not anticipate claim 19, as it does not disclose the other shared elements of claims 17 and 19, as shown above.

Tasi, Taken Alone, or in Combination With Bruhn, Does Not Make Appellant's Claims Obvious

The examiner's rejection of claim 18 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Tasi, as applied to claim 16, and further in view of Bruhn, is improper. The appellant believes that this invention as presently claimed falls outside of the subject matter indicated, taught, or suggested by the

combination of Tasi and Bruhn. Referring back to the MPEP § 706.02(j) criteria for obviousness, stated above, to establish a prima facie case of obviousness, the examiner must shown that the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner correctly states that the Appellant dos not dispute the teachings of Bruhn, or the fact that Bruhn could theoretically be combinable with Tasi. However, Appellant maintains his belief that claims 16-19 are each patentable over the Tasi reference. As explained in the Appellant's initial brief, and above, the anticipation and obviousness rejections of Appellant's claims over Tasi are improper. Consequently, combining Tasi with Bruhn would not make the Appellant's claims obvious because Tasi fails to teach or suggest all of the claim limitations present in Appellant's claims. Thus, the 103(a) rejection of claim 18 is improper.

Claims 16-19 are Anticipated by Huang According to the Examiner

The Examiner has stated that claims 16-19 of Appellant's invention are anticipated by Huang. Furthermore, because appellant's claims 16-19 are obvious in view of Huang, as shown above, the appellant's invention is "the same patentable

invention" as the invention in Huang according to 37 C.F.R. § 1.601(n). Thus, an interference must be initiated upon claims 16-19.

Refusal of Initiating an Interference

The appellant respectfully disagrees with examiner's decision that the declaration of an interference is improper. The reasons for the Appellant's belief that an interference is proper are listed in considerable detail in Appellant's Appeal Brief, on pages 16-19.

As an overview, Appellant's claims read over the Tasi reference, as applied to claims 16, 17, and 19, and over Tasi in view of Bruhn as applied to claim 18. Therefore, an interference is proper since the 37 CFR 1.606 prerequisite that the claim be patentable to the Appellant subject to judgment in the interference is met. Further, Appellant's claims comply with 35 USC 135(b) as the claims include substantially the same subject matter as the Huang claims since they include all the material limitations of the patent claims. Thus, the Examiner's decision not to initiate an interference against the Huang patent was incorrect.

Conclusion

For the foregoing reasons, Appellant respectfully requests that the Examiner's findings of anticipation and obviousness with respect to all of the claims be overturned, and that an interference be initiated against the Huang patent.

January 3, 2004

Respectfully Submitted,



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on January 3, 2004,

for a U.S. Patent Application for Child-Resistant Utility Lighter;
Inventor: Sung, K.;
Examiner: Cocks, J. (Unit 3743);
Serial No.: 09/716,573;
Attorney Docket No. 00-11-1450

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